REMARKS

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Pending claims

Claims 1, 2, 14-29, 46, and 47 are currently pending as they are the claims for which Applicants have paid. Claims 3-13 and 30-45 were canceled as stated in Item 3 of the "Transmittal Letter to the United States Patent and Trademark Office Request for Filing a Patent Application under 35 U.S.C. 1.53 (b)." A copy of the transmittal letter is enclosed for the Examiner's convenience. Applicants submit that these claims were included in the application as filed in interest of providing notice to the public of certain specific subject matter intended to be claimed, and were intended to be canceled at the time of filing this application in the interest of reducing filing costs. Applicants expressly state that these claims are **not** being canceled for reason related to patentability, and are in fact fully supported by the specification as filed. Applicants expressly reserve the right to reinstate these claims or to add other claims during prosecution of this application or a continuation or divisional application. Applicants expressly do not disclaim the subject matter of any invention disclosed herein which is not set forth in the instantly filed claims. For clarification purposes, please cancel claims 3-13 and 30-45 without prejudice or disclaimer.

By this Amendment, claims 1, 2, 18, 25 and 26 were amended to place the claims in better form for examination and have not been made for reasons relating to patentability.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions. Applicants' election is directed to the claims for which Applicants have paid, claims 1, 2, 14-29, 46, and 47.

Group I (claims 1-2, 17-18 and 46) drawn to a polypeptide, class 530, subclass350.

Group II (claim 47) drawn to a polynucleotide, class 536, subclass 23.5

Group V (claims 14-16) or Group XIV (claims 28-29) drawn to a method of detecting a target polynucleotide or a method of screening with polynucleotides, respectively, each classified in class 435, subclass 6.

Group VI (claim 19), Group IX (claim 22) or Group XII (claim 25) drawn to a method of treating by administering a polypeptide, a method of treating with an agonist, or a method of treating with an antagonist, respectively, each classified in class 424, subclass 184.1.

GroupVII (claim 20), Group X (claim 23) or Group XIII (claims 26-27) drawn to a method of screening a compound as a agonist, a method of screening a compound as a antagonist or a method of screening for compounds that bind to or modulate the polypeptide of claim 1, respectively, each classified in class 435, subclass 4.

Group VIII (claim 21) or Group XI (claim 24) drawn to an agonist or drawn to an antagonist, respectively, each classified in class 530, subclass 350.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-2, 17-18 and 46. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications. Applicants traverse this Restriction Requirement on several grounds.

First, Applicants traverse on the grounds that the Examiner could also examine claims 19, 20, 22, 23 and 25-28 (Groups VI, VII, IX, X, XII-XIV), directed to methods of using the polypeptides of claim 1. The method claims are directed to a product (i.e., the polypeptides of claim 1), which are of the same scope as the claimed polypeptides to be searched by the Examiner. Therefore, a search of the claimed polypeptides would substantially overlap examination of the method claims of Groups VI, VII, IX, X, XII-XIV and would not be an undue burden on the Examiner.

Moreover, the method claims of Groups VI, VII, IX, X, XII-XIV are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. 821.04 as follows:

> Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

It is also noted that claims to the polynucleotide sequence of claim Group II, claim 47, as well as claims directed to complementary polynucleotides, expression vectors containing the polynucleotides and a host cell containing the expression vector, have already been examined and allowed in the parent application. Claim 47 in the present case is the same polynucleotide invention as previously allowed in the parent application but of a different scope from the previously allowed claims. Applicants respectfully submit that claim 47, along with claim Group V, claims 14-16 (drawn to methods of use of

the polynucleotides), should be examined together with the polypeptide claims of Group I, as discussed above in connection with the rejoinder of product and process claims.

Further, claim Group VIII (claim 21) and claim Group XI (claim 24) are product by process claims depending from the method of use claims which would be rejoined and examined in compliance with Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in Light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)." Therefore, claims 21 and 24 should also be examined along with the claims of Group I.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The paragraph beginning at line 3 of page 1 has been amended as follows:

This application is a divisional application of USN 09/055,113, filed April 4, 1998, now U.S. Patent Number 6,265,565, the contents of which are hereby incorporated by reference.

IN THE CLAIMS:

Claims 3-13 and 30-45 have been canceled.

Claims 1, 2, 18, 25 and 26 have been amended as follows:

1. (Once Amended) An isolated polypeptide [comprising an amino acid] sequence selected from the group consisting of:

a) a polypeptide comprising an amino acid sequence of SEQ ID NO:1,

b) a polypeptide comprising a naturally occurring [polypeptide comprising an] amino acid sequence at least 90% identical to an amino acid sequence of SEQ ID NO:1,

c) a biologically active fragment of a polypeptide having an amino acid sequence of SEQ ID NO:1, and

d) an immunogenic fragment of a polypeptide having an amino acid sequence of SEQ ID NO:1.

2. (Once Amended) An isolated polypeptide of claim 1, [having a] comprising the amino acid sequence of SEQ ID NO:1.

18. (Once Amended) A composition of claim 17, wherein the polypeptide [has] comprises an amino acid sequence of SEQ ID NO:1.

25. (Once Amended) A method for treating a disease or condition associated with overexpression of functional PRAEP, comprising administering to a patient in need of such treatment a composition of claim 24.

26. (Once Amended) A method of screening for a compound that specifically binds to the polypeptide of claim 1, said method comprising [the steps of]:

a) combining the polypeptide of claim 1 with at least one test compound under suitable conditions, and

b) detecting binding of the polypeptide of claim 1 to the test compound, thereby identifying a compound that specifically binds to the polypeptide of claim 1.